

CERTIFICATE OF MAILING PURSUANT TO 37 C.F.R. § 1.8

I hereby certify that this Petition to Accept Application Due to Inventor Refusing to Join, along with Statement Regarding Non-Signing Inventor, pursuant to 37 C.F.R. § 1.8, is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Mail Stop: Petitions/ Missing Parts, Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22323-1450, on:

Date:

February 25, 2004

By:

Glenn Fitzgerald
Signature of Person Mailing Correspondence



**IN THE UNITED STATES PATENT AND
TRADEMARK OFFICE**

PATENT

Applicant(s):	Marc Benkert et al.	Docket No.:	60655.1100
Serial No.:	10/600,843	Group Art Unit:	3629
Filed:	June 19, 2003	Examiner:	NYA
TITLE:	SYSTEM AND METHOD FOR FACILITATING A SUBSIDIARY CARD ACCOUNT		

**PETITION TO ACCEPT APPLICATION DUE TO INVENTOR REFUSING TO JOIN
PURSUANT TO 37 C.F.R. §1.47(a)**

Mail Stop: Petition/Missing Parts
Assistant Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22323-1450

Dear Assistant Commissioner:

The following Petition is submitted in conjunction with the Examiner's Notice to File Missing Parts of Non-provisional Application mailed August 27, 2003 for which the time period for response expired October 27, 2003.

The Examiner is permitted to charge any fees regarding this Petition to accept, or credit any overpayment, to deposit account No. 19-2814. A duplicate copy of this request is enclosed for your use.

**PETITION TO ACCEPT APPLICATION DUE TO INVENTOR REFUSING TO JOIN
PURSUANT TO 37 C.F.R. §1.47(a)**

In conjunction with the response to the Notice to File Missing Parts mailed August 27, 2003 in the Application, wherein it is noted that the inventor's oath or Declaration is missing, Applicants/Petitioners hereby Petition the Commissioner to accept the enclosed Declarations executed by the signing inventors on behalf of themselves and non-signing inventor Grace Park. Inventor Grace Park refuses to join with the remaining joint inventors in the above-identified Application for patent.

In accordance with the section 1.47(a), if a joint inventor refuses to join in an Application for patent, the Application may be made by the other inventors on behalf of the signing inventors and non-signing inventors. Section 1.47(a) requires that:

1. all available joint inventors must make an oath or Declaration on their own behalf, and make an oath or Declaration on behalf of the non-signing inventor;
2. the Application must be accompanied by a Petition including proof of pertinent facts, namely the details relating to the non-signing inventor's refusal to execute the Application papers;
3. the Petition must indicate the last known address of the non-signing joint inventor; and
4. payment of the fee set forth in section 1.17(h).

1. Oath Or Declaration Is Made By All Available Inventors and On Behalf Of The Non-Signing Inventor

Accompanying this Petition are Declarations executed in compliance with 37 C.F.R. §1.63. The Declarations are signed by all available joint inventors on their own behalf, with the signature block of the non-signing inventor, Grace Park, left blank. Thus, in accordance with MPEP §409.03(a), where an oath or Declaration is signed by all the available inventors with the signature block of the non-signing inventor left blank, the Declaration may be treated as having been signed by all the available inventors on behalf of the non-signing inventors.

2. Proof Of Pertinent Facts, Namely, The Details Relating To The Non-Signing Inventor's Refusal To Execute The Application Papers

Ms. Parks has demonstrated through her conduct that she refuses to join with the remaining joint inventors in the above-identified Application for patent. In general, after a number of diligent efforts to contact Ms. Park and provide her with the opportunity to examine the Application, including the specification, claims, figures, and executable Declaration, it is clear that Ms. Park declines to join with her co-inventors in acknowledging her role as a co-inventor. Ms. Park has offered no reason for her refusal to review the documents and execute the Declaration, and indeed, as of the date of this Petition, no communication has been received from her.

Briefly, it is our belief that Ms. Park is one of the original and first joint inventors of the subject matter which is claimed in the above-identified Application. It is also our belief that she participated in the conception of the invention of the above-identified Application while a full-time, salaried employee of American Express, under American Express's instruction, and within the scope of her duties as an employee of American Express. As such, she was subject to American Express employee policies which include a requirement to assign all inventions from all employees to American Express.

On multiple occasions, Ms. Park was provided the opportunity to execute the documents and based upon her lack of response, it is apparent that she prefers not to sign the Declaration. Specifically, initial attempts to contact Ms. Park by internal American Express e-mail on August 12, 2003 and September 23, 2003 went unanswered. It was later discovered on December 4, 2003, that her employment with the company had ended. Additional attempts to contact Ms. Park at her last known address by Fed Ex® delivery of the Application, Declaration and Assignment on February 3, 2004 resulted in a notice of receipt signed by her, but she has still failed to respond with an executed Declaration. Also, an attempt on February 18, 2004 to contact Ms. Park by telephone was unsuccessful. The telephone number was non-responsive and no forwarding number was given. Thus, it is clear that Ms. Park implicitly refuses to join with the signing inventors in the prosecution of the Application.

3. Last Known Address Of The Non-Signing Joint Inventor

In accordance with MPEP §409.03(e), a Petition filed pursuant to 37 C.F.R. §1.47(a) must state the last known address of the non-signing inventor. The address should be the last known address at which the inventor customarily receives mail. The last known address at which the inventor Grace Park customarily receives mail and of which the Petitioners are aware is:

1024 Preserve Park
Great Falls, VA 22066.

4. Fees

The Examiner is permitted to charge the fees identified below and any additional fees regarding this Petition or credit any overpayment, to deposit account No. 19-2814. A duplicate copy of this request is enclosed for your use.

Action	Fee
Petition for Acceptance (§1.17(h))	\$130.00
Total Fee Due	\$130.00

REMARKS


Applicants submit this Petition For Acceptance Of The Application Due To Inventor's Refusal To Join in the prosecution of the Application. Applicants believe that the Petition read in conjunction with the attached Declaration, Statement executed by Patrice Jacobsen, and Exhibits, fully satisfies the requirements for acceptance of the Application, pursuant to 37 C.F.R. §1.47(a). Thus, Applicants respectfully request favorable consideration of the above Petition.

Should the Examiner wish to discuss any of the above in greater detail or deem that amendments should be made to improve the form of the Application or Petition, then the Examiner is invited to telephone the undersigned at the Examiner's convenience.

Respectfully submitted,

Date: February 25, 2004

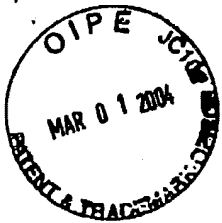
By



Robert A. Iussa
Reg. No. 51,337

SNELL & WILMER L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6226

1476414.1



IN THE UNITED STATES PATENT AND PATENT
TRADEMARK OFFICE

PATENT

Applicant(s): Marc Benkert et al. Docket No.: 60655.1100
Serial No.: 10/600,483 Group Art Unit: 3629
Filed: June 19, 2003 Examiner: NYA
TITLE: **SYSTEM AND METHOD FOR FACILITATING A SUBSIDIARY
CARD ACCOUNT**

STATEMENT REGARDING NON-SIGNING INVENTOR GRACE PARK

STATE OF NEW YORK)
) SS.
County of New York)

I, Patrice Jacobson, hereby affirm that to the best of my personal knowledge:

1. I am Senior Legal Manager, General Counsel's Office with American Express Travel Related Services Company, Inc. ("American Express"). In accordance with my duties at American Express, I am involved with communicating various patent related documents to various inventors, including, but not limited to, forwarding drafts of American Express funded patent applications to the appropriate inventors for review and approval, and forwarding to the inventors the appropriate inventors' declarations for execution.
2. Snell & Wilmer L.L.P. ("Snell & Wilmer") represents American Express in regards to certain intellectual property matters. I have personally communicated with Snell & Wilmer on many of American Express's intellectual property matters. More particularly, I worked with David Wood of Snell & Wilmer, who, at that time, was the American Express outside patent counsel most closely involved with the preparation and prosecution of the above noted U.S.

application, serial no. 10/600,483 ('483) filed on June 19, 2003 entitled, "SYSTEM AND METHOD FOR FACILITATING A SUBSIDIARY CARD ACCOUNT;" attorney docket no. 60655.1100. Mr. Wood is no longer with Snell & Wilmer and another associate, Mr. Robert Iussa, has assumed the prosecution duties. American Express retained Snell & Wilmer to prepare other applications related to subsidiary card technology, including:

a) U.S. provisional patent application Serial no. 60/294,107 ('107) filed May 29, 2001; attorney docket no. 40655.6350.

b) U.S. non-provisional patent application no. 10/155,332 ('332) filed May 23, 2002 entitled, "SYSTEM AND METHOD FOR A PREPAID CARD ISSUED BY A FOREIGN FINANCIAL INSTITUTION;" attorney docket no. 40655.6300.

c) U.S. non-provisional patent application no. 10/128,949 ('949) filed April 23, 2002 entitled, "SYSTEM AND METHOD FOR FACILITATING A SUBSIDIARY CARD ACCOUNT;" attorney docket no. 40655.7900.

3. For clarification, the attorney docket numbers are included in order to match references to such numbers in the attached Exhibits to the corresponding serial numbers. This '483 application is a continuation in part of the '332 and the '949 application, and the '332 claims priority to, and the benefit of the '107 provisional application.

Declarations

4. While preparing the '107 provisional application, the '332 non-provisional application, and the '949 non-provisional applications, American Express along with attorneys David Wood and Patrick Mixon determined that Ms. Grace Park contributed to those inventions and also to this subsequently filed continuation in part '483 application. For example, see the declarations executed by Ms. Park from the earlier applications (See Exhibit A). Thus, Ms. Park is listed as an inventor on all the noted applications, including the '483 application to which this Statement

pertains. It is clear that Ms. Park acknowledged her role as a co-inventor in the earlier applications when she executed the previous declarations, evidenced by her signature. As such, Ms. Park understands the role of the inventor and her obligation to review the patent application and properly execute a declaration. As will be shown herein below, Ms. Park was presented with the present invention's application, and despite her previous experience in properly executing the necessary documents, it is apparent that she has made a conscious choice to not respond.

Assignment

5. Ms. Park participated in the preparation of the '107 application, to which the '332 application claims priority, as well as the preparation of the '332 application. On April 13, 2002, Ms. Park executed an assignment of the '332 non-provisional application to American Express (See Exhibit B). The assignment of the '332 application is recorded in the United States Patent and Trademark Office on May 23, 2002 at Reel No. 013271, Frame 0734, as shown in attached Exhibit C.

6. Ms. Park's assignment of rights, shown in paragraph four of the assignment document, also includes the assignment of the full and exclusive right to, *inter alia*, "any provisional, non-provisional, continuation, continuation in part, divisional or other patent application which claims priority" to the '332 non-provisional application. As such, since the present application claims priority to the '332 non-provisional application, Ms. Park has assigned all full and exclusive rights of this application also to American Express.

7. Further, in accordance with paragraph five of the assignment document, Ms. Park agreed, "to transfer to American Express, without further remuneration, a full and exclusive right to any improvements, derivatives works and applications based on, growing out of, or relating to" the

'332 application. She agreed to provide "all reasonable assistance and execute any papers, if accurate, to preserve, acquire and/or perfect American Express's full protection and title in and to the '332 application, as well as any improvements, and to file any applications as noted in the assignment" (See Exhibit B). The '483 application, to which this Statement pertains, is a continuation in part of the '332 application. Thus, the '483 application is an application, "based on, grows out of, and/or relates to" the '332 application, such that Ms. Park has assigned full and exclusive right of the '483 application to American Express.

Statement of Facts

8. As indicated in the correspondence shown in Exhibits D and E, I personally attempted, via e-mail, to contact Ms. Park on August 12, 2003 and September 23, 2003 for the purpose of encouraging her to execute the inventors' declarations and assignments for the present application. By October 30, 2003, neither American Express nor Snell & Wilmer received an executed declaration from Ms. Park (See Exhibit F). Other inquiries on January 4, 2004 and January 25, 2004 revealed that all inventors had signed and returned the declaration except Ms. Park (See Exhibits G and H). By this time, Ms. Park was no longer an American Express employee (See Exhibit L).

9. With respect to the declaration in the present application, I forwarded to Snell & Wilmer on January 29, 2004, the last known address and phone number of Ms. Park in order to have them, under my direction, forward her a copy of the application and declaration (See Exhibit I). As of the date of this Statement, we have not received a response regarding Ms. Park's willingness to execute the declaration.

10. On February 2, 2004, Snell & Wilmer sent via Fed Ex® a copy of the complete application for her review and an executable declaration for her to sign (See Exhibit J).

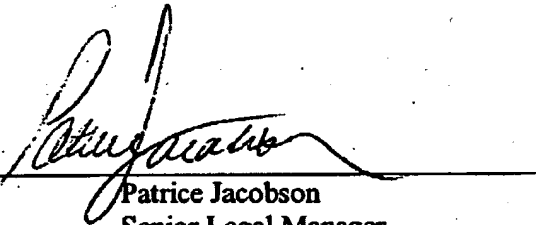
Moreover, it is clear that Ms. Park received the items the following day, February 3, 2004, as evidenced by her clear signature of receipt. (See Exhibit K). Her continued lack of response is compelling evidence that she refuses to sign the declaration.

12. The deadline for responding to the "Notice to File Missing Parts" in the present application expires February 27, 2004. To preserve American Express's rights in the invention, we are filing the present Response, Statement, Exhibits, and Petition for acceptance of the application in view of Ms. Park's refusal to join with the remaining signing inventors.

13. Based upon the inaction from Ms. Park, it is my belief that she is wrongly refusing to sign the declaration and to join in the prosecution of the present application, and that her refusal is implied by her lack of response to our inquiries. Thus, her conduct constitutes refusal sufficient to satisfy the requirements for acceptance of the application under 37 C.F.R. §1.47(a).

I declare under penalty of perjury that the foregoing is true and correct to the best of my knowledge.

DATED this 23 day of February 2004.



Patrice Jacobson
Senior Legal Manager
General Counsel's Office American
Express Travel
Related Service Company, Inc.

Please note that the below Exhibits are protected by the Attorney Client and Attorney Work Product Privileges and no privilege is waived with respect to the subject matter of the communications. Further, certain portions of the emails presented are redacted to protect the privileges pertaining thereto. In addition, certain exhibits have been re-typed and/or include underlining, where indicated, to facilitate understanding of the communication. In any event, the communications shown below are true reproductions of the Exhibits original content.

Exhibit A

Declaration Documents

40655.6300 - Serial No. 10/155,322

40655.7900 - Serial No. 10/128,949



IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

-- PATENT --

Inventor(s): Chris Hobbs, et al.

Docket No.: 40655.6300

Serial No.: NYA

Group Art Unit: NYA

Filing Date: 23 May 2002

Examiner: NYA

Title: SYSTEM AND METHOD FOR PREPAID CARD ISSUED BY A
FOREIGN FINANCIAL INSTITUTION

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and sole inventor (if only one name is listed below) or an original, first and joint (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled:

SYSTEM AND METHOD FOR PREPAID CARD ISSUED BY A FOREIGN FINANCIAL
INSTITUTION

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below, and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Prior Foreign
Application(s)

Priority Not Claimed

[]

Number

Country

Filing Date

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below:

60/294,107

Application Number

May 29, 2001

Filing Date

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

Application NumberFiling DateStatus (Patent, Pending, Abandoned)

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with the Snell & Wilmer, L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

Full name of sole or first joint inventor: Chris HobbsInventor's signature: Date: 23/05/02Residence Address: 479 River Valley Road, #09-06 Valley ParkCity/State: SingaporeZip Code: 248364Citizenship: British CitizenFull name of second joint inventor: Grace Park

Inventor's signature: _____

Date: _____

Residence Address: _____

City/State: _____

Zip Code: _____

Citizenship: _____

I hereby claim the benefit under 35 U.S.C. §119(e) of any United States provisional application(s) listed below:

<u>60/294,107</u>	<u>May 29, 2001</u>
Application Number	Filing Date

I hereby claim the benefit under 35 U.S.C. §120 of any United States application(s), or §365(c) of any PCT International application designating the United States, listed below and, insofar as the subject matter of each of the claims of this application is not disclosed in the prior United States application in the manner provided by the first paragraph of 35 U.S.C. §112, I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in 37 C.F.R. §1.56 which became available between the filing date of the prior application and the national or PCT international filing date of this application:

<u>Application Number</u>	<u>Filing Date</u>	<u>Status (Patent, Pending, Abandoned)</u>
---------------------------	--------------------	--

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with the Snell & Wilmer, L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

Full name of sole or first joint inventor: Chris Hobbs

Inventor's signature: _____ Date: _____

Residence Address: _____

City/State: _____ Zip Code: _____

Citizenship: _____

Full name of second joint inventor: Grace Park

Inventor's signature: [Signature] Date: 4/13/2002

Residence Address: 71 Park Ave, 5A

City/State: NY NY Zip Code: 10016

Citizenship: USA

Full name of third joint inventor: Tomer Rubinshtein
Inventor's signature: TUM Date: 5/9/02
Residence Address: 231 west 75 st # 66
City/State: New York, NY Zip Code: 10001
Citizenship: Israel



IN THE UNITED STATES PATENT
AND TRADEMARK OFFICE

-- PATENT --

Inventor(s): Marc Benkert
Grace Park
Tomer Rubinshtein

Docket No.: 40655.7900

Serial No.: TBD

Group Art Unit: TBD

Filing Date: April 23, 2002

Examiner: TBD

Title: SYSTEM AND METHOD FOR FACILITATING A SUBSIDIARY CARD
ACCOUNT

DECLARATION FOR PATENT APPLICATION

As a below named inventor, I hereby declare that:

My residence, post office address and citizenship are as stated below next to my name.

I believe I am an original, first and sole inventor (if only one name is listed below) or an original, first and joint (if plural names are listed below) of the subject matter which is claimed and for which a patent is sought on the invention entitled

SYSTEM AND METHOD FOR FACILITATING A SUBSIDIARY CARD ACCOUNT

the specification of which is attached hereto.

I hereby state that I have reviewed and understand the contents of the above-identified specification, including the claims, as amended by any amendment referred to above.

I acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me to be material to patentability as defined in Title 37, Code of Federal Regulations, Section 1.56.

I hereby claim foreign priority benefits under Title 35, United States Code, Section 119(a)-(d) or Section 365(b) of any foreign application(s) for patent or inventor's certificate, or Section 365(a) of any PCT International application which designated at least one country other than the United States, listed below, and have also identified below, by checking the box, any foreign application for patent or inventor's certificate or PCT International application having a filing date before that of the application on which priority is claimed.

Full name of second joint inventor: Grace Park

Inventor's signature: [Signature] Date: 4/22/02

Residence Address: 71 Park Ave. 5A

City/State: NY NY 10016 Zip Code:

Citizenship: US

Full name of third joint inventor: Tomer Rubinshtein

Inventor's signature: [Signature] Date: 4/22/02

Residence Address: 231 West 25 st # 6G

City/State: New York, NY Zip Code: 10001

Citizenship: Israel

ASSIGNMENT

UTILITY PATENT

WHEREAS, the undersigned inventor(s) (hereinafter singly and collectively, "ASSIGNOR") of the addresses indicated below, have invented subject matter disclosed in the patent application entitled *SYSTEM AND METHOD FOR A PREPAID CARD ISSUED BY A FOREIGN FINANCIAL INSTITUTION* filed herewith;

AND WHEREAS, AMERICAN EXPRESS TRAVEL RELATED SERVICES COMPANY, INC., a subsidiary of AMERICAN EXPRESS COMPANY (hereinafter "ASSIGNEE"), a corporation organized and existing under and by virtue of the laws of the State of New York having its principal place of business and mailing address at General Counsel's Office, American Express Tower, World Financial Center, New York, New York 10285-4900, is desirous of memorializing its interest therein;

NOW, THEREFORE, the undersigned ASSIGNOR hereby confirms that ASSIGNOR is a full time salaried employee, past employee or a contractor of ASSIGNEE, AMERICAN EXPRESS COMPANY or one of its subsidiary companies, and that ASSIGNOR developed the subject matter of the invention on ASSIGNEE's time and at the expense of ASSIGNEE and within the scope of ASSIGNOR's duties to ASSIGNEE and thereby ASSIGNOR recognizes that the ASSIGNEE owns the invention as described in the aforesaid application. Nonetheless to comport with Patent Office procedures, ASSIGNOR memorializes that relationship in the form of this assignment and;


THEREFORE, for good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, ASSIGNOR by these presents does sell, assign and transfer unto ASSIGNEE, its successors, assigns and legal representatives, the full and exclusive right to the invention, as described in the aforesaid application, including patent, copyright and any other intellectual property rights, any provisional, non-provisional, continuation, continuation in part, divisional, reissue, reexamination, foreign, PCT or other patent application or like document, or any other application which claims priority to said application, in the United States and all foreign countries, together with the right of priority under the International Convention for the Protection of Industrial Property, Inter-American Convention Relating to Patents, Designs and Industrial Models, and any other international agreements to which the United States adheres, and hereby authorizes and requests the Commissioner of Patents to issue said Letters Patent to ASSIGNEE, for the sole use and benefit of ASSIGNEE, its successors, assigns and legal representatives.

AND HEREBY AGREES to transfer to ASSIGNEE, its successors, assigns and legal representatives, without further remuneration, a like interest in and to any improvements, derivative works, and applications based thereon, growing out of or relating to the invention; and to provide all reasonable assistance and execute any papers, if accurate, desired by ASSIGNEE, its successors, assigns and legal representatives, to preserve, acquire and/or perfect ASSIGNEE's full protection and title

representatives, to preserve, acquire and/or perfect ASSIGNEE's full protection and title in and to the invention and any improvements and to file any of the aforementioned applications.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with Snell & Wilmer L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

EXECUTED as of the date(s) written below by ASSIGNOR:

INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
Marc Benkert	<u>417 W. Fellars Drive</u> <u>Phoenix, AZ 85023</u>		<u>4/21/02</u>
Grace Park	<u> </u> <u>New York, NY</u>	<u> </u>	<u> </u>
Tomer Rubinshtein	<u> </u> <u>New York, NY</u>	<u> </u>	<u> </u>



SNELL & WILMER L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, Arizona 85004-2202
(602) 382-6228
Fax (602) 382-6070

Energizer, Marc BENKERT, page 2

in and to the invention and any improvements and to file any of the aforementioned applications.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with Snell & Wilmer L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

EXECUTED as of the date(s) written below by ASSIGNOR:


INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
<u>Chris Hobbs</u>	_____ _____ _____	_____	_____
<u>Grace Park</u>	<u>21 Park Ave, SA</u> <u>NY, NY 10016</u> _____		<u>4/13/2002</u>
<u>Tomer Rubinshtein</u>	<u>231 W 25th St #66</u> <u>New York, NY 10001</u> _____		<u>5/9/02</u>

SNELL & WILMER L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, Arizona 85004-2202
(602) 382-6274
Fax (602) 382-6070

in and to the invention and any improvements and to file any of the aforementioned applications.

In the event that the Application Number and/or filing date is not available when this Assignment is executed, I hereby authorize and request any attorney associated with Snell & Wilmer L.L.P., Customer No. 20322, to insert above the filing date and/or the application number of said application when known.

EXECUTED as of the date(s) written below by ASSIGNOR

INVENTOR'S NAME	ADDRESS	SIGNATURE	DATE
<u>Chris Hobbs</u>	<u>479 River Valley Road</u> <u>#09-06 Valley Park</u> <u>Singapore 248364</u>		<u>23/05/02</u>
<u>Grace Park</u>	_____ _____ _____	_____	_____
<u>Tomer Rubinshtein</u>	_____ _____ _____	_____	_____

SNELL & WILMER L.L.P.
One Arizona Center
400 East Van Buren
Phoenix, Arizona 85004-2202
(602) 382-6274
Fax (602) 382-6070



DECEMBER 02, 2002

PTAS

Under Secretary of Commerce For Intellectual Property and
Director of the United States Patent and Trademark Office
Washington, DC 20231
www.uspto.gov

SNELL & WILMER
PATRICK L. MIXON
ONE ARIZONA CENTER
400 E. VAN BUREN STREET
PHOENIX, AZ 85004



102220869A

40655.6300

**UNITED STATES PATENT AND TRADEMARK OFFICE
NOTICE OF RECORDATION OF ASSIGNMENT DOCUMENT**

THE ENCLOSED DOCUMENT HAS BEEN RECORDED BY THE ASSIGNMENT DIVISION OF THE U.S. PATENT AND TRADEMARK OFFICE. A COMPLETE MICROFILM COPY IS AVAILABLE AT THE ASSIGNMENT SEARCH ROOM ON THE REEL AND FRAME NUMBER REFERENCED BELOW.

PLEASE REVIEW ALL INFORMATION CONTAINED ON THIS NOTICE. THE INFORMATION CONTAINED ON THIS RECORDATION NOTICE REFLECTS THE DATA PRESENT IN THE PATENT AND TRADEMARK ASSIGNMENT SYSTEM. IF YOU SHOULD FIND ANY ERRORS OR HAVE QUESTIONS CONCERNING THIS NOTICE, YOU MAY CONTACT THE EMPLOYEE WHOSE NAME APPEARS ON THIS NOTICE AT 703-308-9723. PLEASE SEND REQUEST FOR CORRECTION TO: U.S. PATENT AND TRADEMARK OFFICE, ASSIGNMENT DIVISION, BOX ASSIGNMENTS, CG-4, 1213 JEFFERSON DAVIS HWY, SUITE 320, WASHINGTON, D.C. 20231.

RECORDATION DATE: 05/23/2002

REEL/FRAME: 013271/0734
NUMBER OF PAGES: 5

BRIEF: ASSIGNMENT OF ASSIGNOR'S INTEREST (SEE DOCUMENT FOR DETAILS).

ASSIGNOR:
HOBBS, CHRIS

DOC DATE: 05/23/2002

ASSIGNOR:
PARK, GRACE

DOC DATE: 04/13/2002

ASSIGNOR:
RUBINSHTEIN, TOMER

DOC DATE: 05/09/2002

ASSIGNEE:
AMERICAN EXPRESS TRAVEL RELATED
SERVICES CO.
GENERAL COUNSEL'S OFFICE
AMERICAN EXPRESS TOWER, WORLD
FINANCIAL CENTER
NEW YORK CITY, NEW YORK 10285

SERIAL NUMBER: 10155332
PATENT NUMBER:

FILING DATE: 05/23/2002
ISSUE DATE:

RECEIVED

DEC 06 2002

SNELL & WILMER

NOTED FOR RECEIPT

013271/0734 PAGE 2

TONYA LEE, EXAMINER
ASSIGNMENT DIVISION
OFFICE OF PUBLIC RECORDS

Snell & Wilmer

L.L.P.
LAW OFFICES

One Arizona Center
Phoenix, Arizona 85004-2202
(602) 382-6000
Fax: (602) 382-6070
www.swlaw.com

Howard I. Sobelman (602) 382-6228
Patents, Trademarks & Copyrights
hsobelman@swlaw.com

PHOENIX, ARIZONA

TUCSON, ARIZONA

IRVINE, CALIFORNIA

SALT LAKE CITY, UTAH

DENVER, COLORADO

LAS VEGAS, NEVADA

February 2, 2004

VIA FEDERAL EXPRESS

Grace Park
1024 Preserve Park
Great Falls, VA 22066

Ref: 60655-1100 Sobelman
Dept: Grace Park

Date: 02FEB04 SHIPPING \$19.41
Wgt: 0.85 LBS SPECIAL \$0.97
HANDLING \$0.00

TOTAL \$20.38

SERVICE: PRIORITY OVERNIGHT
TRACK: 8413 6006 6006

Re: **U.S. Nonprovisional Patent Application**
Title: **SYSTEM AND METHOD FOR FACILITATING A
SUBSIDIARY CARD ACCOUNT**
Serial No.: 10/600,483
Inventors: Benkert, et al.
Filing Date: June 19, 2003
Our File No.: 60655.1100

Dear Ms. Park:

Enclosed are copies of the above-referenced patent application, assignment and declaration. After careful review of these documents, please sign the enclosed assignment and declaration and fax your signature pages to my attention at 602-382-6070. Due to your continued obligations to American Express and your continued duty of confidentiality, please also overnight the originally executed documents and the enclosed patent application to me in the enclosed, pre-addressed envelope. We would appreciate receiving your signed documents by February 13, 2004.

Thank you for your attention to this matter. If you have any questions, please contact me.

Sincerely,

Snell & Wilmer L.L.P.

Howard Sobelman

HIS:dm
Enclosures

Sobelman\PHD\1467365.1

Snell & Wilmer is a member of LEX MUNDI, a leading association of independent law firms.



FedEx Express
Customer Support Trace
3875 Airways Boulevard
Module H, 4th Floor
Memphis, TN 38116

U.S. Mail: PO Box 727
Memphis, TN 38194-4643

Telephone: 901-369-3600

2/9/2004

Dear Customer:

Here is the proof of delivery for the shipment with tracking number 641360066806. Our records reflect the following information.

Delivery Information:

Signed For By: G.PARKS



Delivery Location: 1024 PRESERVE PARK

Delivery Date: February 3, 2004

Delivery Time: 0929

Shipping Information:

Tracking No: 641360066806

Ship Date: February 2, 2004

Recipient:
GRACE PARK

1024 PRESERVE PARK
GREAT FALLS, VA 22066
US

Shipper:
SNELL & WILMER
SNELL & WILMER
400 E VAN BUREN ST FL 10
PHOENIX, AZ 850042202
US

Shipment Reference Information:

60655-1100 SOBELMAN

Thank you for choosing FedEx Express. We look forward to working with you in the future.

FedEx Worldwide Customer Service
1-800-Go-FedEx®
Reference No.: R2004020900111629642

Mier, Deborah

From: Patrice Jacobson [patrice.jacobson@aexp.com]
Sent: Tuesday, August 12, 2003 9:29 AM
To: Stephen X Baumgartner; Chris Hobbs; Kazuhiko A Okamoto; Grace G Park
Cc: Warren D Bieler; Sobelman, Howard; Mier, Deborah; Tracey R Thomas
Subject: ATTORNEY - CLIENT PRIVILEGE (60655.1100 / TH200313642 / Allowance Card) - URGENT ACTION REQUIRED

Importance: High



60655.1100



60655.1100

ssignment.doc (39 . Decl.doc (48 KB)

Dear Inventors - Please note that a utility application was filed that claims priority to the utility applications filed for Project Duracell and Project Energizer. As part of the patent process it is imperative that you print out the attached two forms, execute the form and return them to Deb Mier's attention at her address below as soon as possible. Please note that these documents may be executed in counterparts. Please also fill in your respective residential addresses as well as sign and date the forms.

Thanks and best regards, Patrice

***Warren - Is there anyway that you can assist on obtaining Tomer's execution on the forms as I know that he is in Israel but do not have his residential or e-mail address. Please advise and thanks so very much! Best regards,
Patrice***

Further I cannot locate Marc Benkert in Lotus Notes if someone can assist on obtaining his execution that would also be greatly appreciated.

(See attached file: 60655.1100 Assignment.doc)

(See attached file: 60655.1100 Decl.doc)

----- Forwarded by Patrice Jacobson on 08/12/2003 12:16 PM

From: "Mier, Deborah" <dmier@swlaw.com> on 08/12/2003 11:51 AM
To: Patrice Jacobson
cc: Tracey R Thomas/AMER/TRS/AEXP@AMEX, "Sobelman, Howard"
<hsobelman@swlaw.com>
Subject: ATTORNEY - CLIENT PRIVILEGE (60655.1100 / TH200313642 / Allowance Card)

Patrice,
Attached are the inventorship documents for the above-referenced matter. Please have each of the inventors complete, sign and date both documents. Please have them fax their completed documents to me as soon as possible for filing with the U.S. Patent Office. We also need to have them send the originals to me asap as well. Thanks for your assistance.
Deb

Deborah A. Mier, Legal Secretary to Howard Sobelman

Exhibit E

From: Patrice Jacobson on 9/23/2003 03:16 PM

To: Chris Hobbs@AMEX, Grace G. Park/AMER/SVG/AEXP@AMEX
cc: hsobelman@swlaw.com, dmier@swlaw.com, Tracey R. Thomas/AMER/TRS/AEXP@AMEX
Subject: ATTORNEY - CLIENT PRIVILEGE (60655.1100 / TH200313642 / Allowance
Card) - URGENT ACTION REQUIRED - 2nd REQUEST

Chris/Grace- Please print out the below attached documents, execute them and return them to Deb Mier's attention at Snell & Wilmer as soon as possible. Thanks, Patrice.

Mier, Deborah

From: Patrice Jacobson [patrice.jacobson@aexp.com]
Sent: Thursday, December 04, 2003 7:44 AM
To: Mier, Deborah
Cc: Sobelman, Howard
Subject: Re: Attorney - Client Privilege (60655.1100 / TH200313642 / Allowance Card)

Deb - Grace no longer works for the company and no one knows where she is - I will try and follow-up once more. PJ

From: "Mier, Deborah" <dmier@swlaw.com> on 12/03/2003 11:43 PM

To: Patrice Jacobson@AMEX
cc: "Sobelman, Howard" <hsobelman@swlaw.com>
Subject: Attorney - Client Privilege (60655.1100 / TH200313642 / Allowance Card)

Patrice,
We are also still missing signed inventorship documents from Marc Benkert and Grace Park. From Marc's email of 10/31/03 he was going to get these documents signed and sent to us by the end of the year, if you think it is appropriate to remind him we would appreciate it. Any word from Grace?

The next deadline is 12/27/03 with a 2 mo. extension (\$420) plus the \$130 surcharge. Thanks. Deb

Deborah A. Mier, Legal Secretary to Howard Sobelman
Snell & Wilmer L.L.P.
One Arizona Center
400 E. Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6123
Fax: (602) 382-6070
E-mail: dmier@swlaw.com

The information contained in this electronic mail message is confidential information intended only for the use of the individual or entity named above, and may be privileged. If the reader of this message is not the intended recipient or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone (602/382-6000), and delete the original message.

American Express made the following
annotations on 12/04/2003 07:43:46 AM

Exhibit F

-----Original Message-----

From: Patrice Jacobson [mailto:patrice.jacobson@23xp.com]

Sent: Thursday, October 30, 2003 9:23 AM

To: Sobelman, Howard

Cc: Trace R Thomas; Bob Barnes; Jeff S Fehlhaber, Mier, Deborah

Subject: Re: FW: ATTORNEY - CLIENT PRIVILEGE (60655.1100 / Allowance Card / TH200313642)

Howard - I believe that I have retained a few e-mails that I sent to these people asking them to execute the documents. At this point, I can send the e-mails to you and we will need to file a "hostile inventor" document then - If I am assummer correctly. Tomer is in Israel, I know that. We can contact Chris Hobbs agains since he is still working for the company. As for the other people, Grace Park and Marc Benkert, I do not know. Please advise how we should handle. Regards, Patrice

Mier, Deborah

From: Mier, Deborah
Sent: Friday, January 23, 2004 1:48 PM
To: 'Patrice Jacobson'
Cc: Sobelman, Howard; 'Tracey R Thomas'
Subject: RE: URGENT RE: Attorney - Client Privilege (60655.1100 / TH200313642 / Allowance Card)

Patrice,
Any luck getting signed documents from Marc and Grace?
Thanks.
Deb

Deborah A. Mier, Legal Secretary to Howard Sobelman
Snell & Wilmer L.L.P.
One Arizona Center
400 E. Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6123
Fax: (602) 382-6070
E-mail: dmier@swlaw.com

The information contained in this electronic mail message is confidential information intended only for the use of the individual or entity named above, and may be privileged. If the reader of this message is not the intended recipient or the employee or agent responsible to deliver it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by telephone (602/382-6000), and delete the original message.

-----Original Message-----

From: Mier, Deborah
Sent: Thursday, January 08, 2004 1:36 PM
To: 'Patrice Jacobson'
Cc: Sobelman, Howard; 'Tracey R Thomas'
Subject: URGENT RE: Attorney - Client Privilege (60655.1100 / TH200313642 / Allowance Card)
Importance: High

Patrice,
This is a follow-up to my December 3, 2003 email. We are still missing signed inventorship documents from Marc Benkert and Grace Park. From Marc's email of 10/31/03 he was going to sign the inventorship documents and send them to us by the end of the year, have you received them? Any word from Grace?

The next deadline is 1/27/03 with a 3 mo. extension (\$950) plus the \$130 surcharge for late filed declaration.

The drop-dead date is 2/27/04 with a 4 mo. extension (\$1,480) plus the \$130 surcharge for late filed declaration.

We would greatly appreciate your assistance in this matter.
Deb

Deborah A. Mier, Legal Secretary to Howard Sobelman
Snell & Wilmer L.L.P.
One Arizona Center
400 E. Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6123
Fax: (602) 382-6070
E-mail: dmier@swlaw.com

Mier, Deborah

From: Patrice Jacobson [patrice.jacobson@aexp.com]
Sent: Friday, January 23, 2004 2:19 PM
To: Marc P Benkert
Cc: Mier, Deborah; Tracey R Thomas; Sobelman, Howard
Subject: Re: ATTORNEY - CLIENT PRIVILEGE (60655.1100 / TH200313642 / Allowance Card) - URGENT ACTION REQUIRED

Importance: High



60655.1100

Assignment.doc (39 KB)



60655.1100

Decl.doc (48 KB)

Marc - It was such a pleasure talking to you today and I am happy that I found you! As per our conversation here is what I need for you to do:

1. Print out each attached document.
2. Execute each document.
3. Fax the documents to Deb Mier's attention at Snell & Wilmer at 602-382-6070.
4. Send the originally executed documents back to Deb Mier's attention at her address below.

Please feel free to call me at 516-378-4294 should you have any questions.

Thank you for all your assistance on this matter!

Best regards, Patrice

(See attached file: 60655.1100 Assignment.doc)

(See attached file: 60655.1100 Decl.doc)

Deborah A. Mier, Legal Secretary to Howard Sobelman
Snell & Wilmer L.L.P.
One Arizona Center
400 E. Van Buren
Phoenix, AZ 85004-2202
Phone: (602) 382-6123
Fax: (602) 382-6070

American Express made the following
annotations on 01/23/2004 02:36:27 PM

"This message and any attachments are solely for the intended recipient and may contain confidential or privileged information. If you are not the intended recipient, any disclosure, copying, use, or distribution of the information included in this message and any attachments is prohibited. If you have received this communication in error, please notify us by reply e-mail and immediately and permanently delete this message and any attachments. Thank you."

=====

Mier, Deborah

From: Patrice Jacobson [patrice.jacobson@aexp.com]
Sent: Thursday, January 29, 2004 10:41 AM
To: Mier, Deborah
Subject: Re: Ex-Amex employee whereabouts

Here is address information. Regards, PJ

----- Forwarded by Patrice Jacobson on 01/29/2004 12:40 PM

From: Jennifer Oquendo on 01/27/2004 04:44 PM

To: Patrice Jacobson@AMEX
cc:
Subject: Re: Ex-Amex employee whereabouts (Document link: Patrice Jacobson)

Here is the info you requested. I can only provide last known address and phone number from peoplesoft. See below....Jen

From: Patrice Jacobson on 01/27/2004 04:31 PM

To: Jennifer Oquendo@AMEX
cc:
Subject: Re: Ex-Amex employee whereabouts (Document link: Jennifer Oquendo)

well - I am trying to track down ex-Amex employees that are named as inventors on certain patent matters. I need for example there last recorded address, phone number and e-mail address, if possible as I need to send these people documents to sign - or attempt to sign as the US Patent and Trademark Office needs to see proof that we tried to contact these people to get there signature.

I am looking for the following people (for now):

Alexandra Mayers - 49 Grove Street, Apt. 5B, New York, New York 10014, No phone number listed. Pragnesh Ray [confirm name; no listing in peoplesoft of this person; if contractor, I don't have access to that info] Grace Park-1024 Preserve Court, Great Falls, VA 22066, Telephone: 703-394-4712

Any assistance you can provide would be great.

Thanks, Patrice

From: Jennifer Oquendo on 01/27/2004 04:27 PM

To: Patrice Jacobson@AMEX
cc:
Subject: Re: Ex-Amex employee whereabouts (Document link: Patrice Jacobson)

what information do you need? Jen

From: Patrice Jacobson on 01/27/2004 04:22 PM